

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 11, 26-29, and 36-39 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, Claims 11, 26-29, and 36-39 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement regarding the term “multifunctional;” and Claims 11, 26-29, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,851 to Imada (hereinafter “the ‘851 patent”) in view of U.S. Patent No. 5,818,900 to Hashimoto et al. (hereinafter “the ‘900 patent”), U.S. Patent No. 4,448,515 to Ishikawa (hereinafter “the ‘515 patent”), U.S. Patent No. 6,353,482 B1 to Abe et al. (hereinafter “the ‘482 patent”), and U.S. Patent No. 5,602,625 to Okamoto et al. (hereinafter “the ‘625 patent”).

Claim 11 is directed to an operation and display section of an operation unit for an image forming apparatus, comprising, *inter alia*: (1) a touch screen panel substantially centered on the operation unit; (2) numeral keys and an enter key located at a right-hand side of the touch panel screen; (3) a clear/stop key located to a right-hand side of the numeral keys and the enter key; and (4) *a multifunctional set/counter key located to a top left-hand side of the touch panel screen, the set/counter key configured to vary initial set values and operating conditions in accordance with conditions of use.*

Regarding the rejection of Claims 11, 26-29, and 36-39 under 35 U.S.C. § 112, first paragraph, Applicants submit that the set/counter key inherently performs multiple functions. First, by including a slash between “set” and “counter,” the term “set/counter” implies that the set/counter key performs multiple functions. For example, by way of analogy, Applicants point out that Claim 11 also recites a clear/stop key, which the specification describes as “for

canceling a numerical value input *or* interrupting *or* ending a copying operation.”¹ Further, Applicants note that the specification discloses that the set/counter key is for varying initial set values *and* operating conditions in accordance with the conditions of use. Thus, the specification discloses that the set/counter key has two purposes: (1) for varying initial set values; and (2) for varying initial operating conditions. Accordingly, Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 112, first paragraph.

Regarding the rejection of Claim 11 under 35 U.S.C. § 103, the Office Action asserts that the ‘851 patent discloses everything in Claim 11 with the exception of an enter key, a program key, a trial copy key, a copy key, a copy server key, and a printer key, and relies on the ‘900, ‘515, ‘482, and ‘625 patents to remedy those deficiencies. Further, the Office Action asserts that “Imada does not expressly refer to the counter key to be a set/counter key....however, as is known in the art the set key which is also known as a counter key or set/counter key in this context are generally used to refer to a same function which is to allow an [sic] user to set a desired number/count of copies to be made.”² Further, to support the above argument, the Office Action refers to the disclosures of a “set” key in the ‘625 patent and in U.S. Patent No. 6,296,243 to Nishimura (hereinafter “the ‘243 patent”).

The ‘851 patent is directed to an image processing apparatus having a counter key 62 located on the left side of a keyboard/display device 3.³ However, as admitted in the Office Action, the ‘851 patent fails to explicitly disclose a set/counter key. Moreover, the ‘851 patent fails to disclose that the counter key 62 is a *multifunctional key configured to vary initial set values and operating conditions in accordance with the conditions of use*, as recited in Claim 11.⁴ Accordingly, Applicants respectfully submit that the ‘851 patent fails to disclose or suggest that the counter key 62 is alternatively known as a set key, a counter key,

¹ See page 7, lines 1-2, of the specification. Emphasis Added.

² See pages 3 and 4 of the Office Action dated January 2, 2004.

³ ‘851 patent, Figure 3.

⁴ In fact, the ‘851 patent refers to the counter key 62 exactly one time, in column 4, line 37, and does not define the functionality of that key. However, element 62 is also shown in Figure 3 of the ‘851 patent.

or a set/counter key, as asserted by the Office Action. Rather, the '851 merely discloses an image forming apparatus having "a counter key 62," whose function is not disclosed.

Turning now to the secondary references, Applicants respectfully submit that each of the '900, '515, '482, and '625 patents fail to disclose the set/counter key recited in Claim 11. Further, Applicants note that the set key disclosed by the '625 patent, which the Office Action asserts is functionally equivalent to the counter key disclosed by the '851 patent, is a "copy number set key 108 for inputting numerals 0-9."⁵ However, as shown in Figure 4 of the '625 patent, the copy number set key 108 is actually a ten-key numeric keypad. Thus, Applicants fail to understand the assertion in the Office Action that "[i]t would have been obvious to an artisan at the time of the invention that Okamoto's set key and Imada's counter key are the same key functionally."⁶ First, the '625 set key actually refers to ten keys.⁷ Second, the functionality of the counter key disclosed by the '851 patent is unknown, as the '851 patent is completely silent regarding the counter key 62. Thus, Applicants respectfully submit that the set key disclosed by the '625 patent and the counter key disclosed by the '851 patent are not functionally related.

Thus, no matter how the teachings of the '851, '900, '515, '482, and '625 patents are combined, the combination does not teach or suggest a multifunctional set/counter key configured to vary initial set values and operating conditions in accordance with the conditions of use, as recited in Claim 11. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 11 (and dependent Claims 26-29) should be withdrawn.

Further, Applicants note that, despite the assertion in the Office Action that it is "known in the art" that the set key is also known as the counter key or the set/counter key, the

⁵ '625 patent, column 20, lines 39 and 40.

⁶ Page 4 of the January 2, 2004, Office Action.

⁷ Applicants also note that the set key disclosed by the '243 patent, which was asserted by the Office Action to be equivalent to the '851 counter key, also refers to a numeric key pad, as shown in Figure 2.

Office Action has failed to provide any evidence to support this assertion. First, the “set” key disclosed by each of the ‘243 and ‘625 patents is merely a numeric keypad, which is a separate element recited in Claim 11. Accordingly, the set keys disclosed by the ‘243 and ‘625 patents are unrelated to the set/counter key recited in Claim 11, since they refer to another element recited in Claim 11. Further, regarding the ‘851 patent, the Office Action asserts that “the counter key is used to set the initial values, such as number of copies, and the key could also be used later to modify the already set number of copies depending on conditions of use.”⁸ However, Applicants note again that the ‘851 patent is completely silent as to the function of the counter key 62 and that the Office Action merely speculating as to its function. Accordingly, Applicants fail to see the significance of the disclosure of a counter key having no description to a set/counter key configured to vary initial set values and operating conditions in accordance with conditions of use, as recited in Claim 11.

Independent Claims 36, 37, and 39 recite limitations analogous to the limitations recited in Claim 11. Accordingly, for the reasons stated above for the patentability of Claim 11, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejections of Claims 36, 37 (and dependent Claim 38), and 39 are rendered moot by the present amendment to those claims.

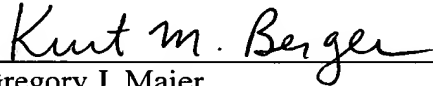
Thus, it is respectfully submitted that independent Claims 11, 36, 37, and 39 (and all associated dependent claims) patentably define over any proper combination of the ‘851, ‘900, ‘515, ‘482, and ‘625 patents.

⁸ Page 3 of the January 2, 2004, Office Action.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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